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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/997,450	11/30/2001	Shamim M. Malik	50623.61	3442

7590 06/28/2005

Squire, Sanders & Dempsey L.L.P.  
One Maritime plaza, Suite 300  
San Francisco, CA 94111

EXAMINER
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HO, UYEN T

ART UNIT	PAPER NUMBER
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3731

DATE MAILED: 06/28/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

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<b>Office Action Summary</b>	<b>Application No.</b> 09/997,450	<b>Applicant(s)</b> MALIK ET AL.	
	<b>Examiner</b> (Jackie) Tan-Uyen T. Ho	<b>Art Unit</b> 3731	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 08 April 2005.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-44 is/are pending in the application.
- 4a) Of the above claim(s) 11, 12 and 20 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) 1-10, 13-19, 21, 22-44 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

***Election/Restrictions***

1. Applicant's election of Species 1 (claims 1-10,13-19,21-22) in the reply filed on 7/6/04 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)). This application contains claims 11,12,20 drawn to an invention nonelected with traverse in Paper filed on 7/6/04. A complete reply to the final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

***Response to Arguments***

2. Applicant's arguments filed 4/8/05 have been fully considered but they are not persuasive. Applicant argues that the cited combination does not teach a compound that is "implanted at a depth..." as claimed. Examiner disagrees. The claims recite "implanted at a depth within at least a region of a surface of the stent" and examiner consider that as the material TiN<sub>x</sub> as disclosed by Lazorov implanted or placed into the holes/deposits on the surface of the stent as disclosed by Ndondo-Lay, the material is implanted at a depth within at least a region at the holes/deposits of the surface of Ndondo-Lay's stent. The surface of the stent at the lip of the holes/deposits and as the material within the holes/deposits, it is "implanted at a depth..." Examiner considers "a depth within at least a region of a surface of the stent" is the depth of the holes/deposits of Ndondo-Lay's stent. Note: The introductory statement of intended use and all other functional statements have been carefully considered but are deemed not to impose

any structural limitations on the claims distinguishable over the Ndondo-Lay's device which is capable of being used as claimed if one desires to do so.

Newly added claims recite the limitation that a compound is "implanted by plasma reaction" place the claims in Product-by-Process condition. The claims are directed to the product which is a stent having material implanted at a depth within at least a region of a surface of the stent, the claims are unpatentable even though the prior art product was made by a different process (MPEP 2113). Examiner considers that the device of the combined teaching includes the same limitations of the device as claimed, a stent that has material as claimed "implanted at a depth within at least a region of a surface of the stent." Therefore, the previous rejections are remained.

### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-10, 13-19, 21 and 22-44 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ndondo-Lay (6,273,908) in view of Windecker et al. (Circulation, August 21,2001; 104:928-933) or Lazarov (6,110,204 or US2003/0044596) or Huang et al. (US 2003/0175444). Ndondo-Lay discloses a stent with depots for containing biocompatible materials or drugs. Although, Ndondo-Lay does not disclose the biocompatible materials or drugs being TiN<sub>x</sub>O<sub>y</sub> compound as claimed, attention is

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directed to Windecker et al., Lazorov, or Huang et al. references which disclose the compound as claimed being used on stent for reducing neointimal hyperplasia or to improve the biocompatible surface of the stent. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to employ TiNxOy compound as claimed onto Ndondo-Lay's stent. Doing so would meet all the limitation as claimed.

In regarding to claims 9 and 19, it would have been obvious matter of design choice to modify the stent of Ndondo-Lay in view of Windecker et al., Lazorov, or Huang et al by having layers of Ti, N, or TiN disposed beneath a layer of TiNxOy, since applicant has disclosed that having layers of Ti, N or TiN disposed beneath the layer of TiNxOy solves any stated problem or is for any particular purpose and it appears that the stent would perform equally well with or without the layers of Ti, N or TiN disposed beneath the layer of TiNxOy.

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to (Jackie) Tan-Uyen T. Ho whose telephone number is 571-272-4696. The examiner can normally be reached on MULTIFLEX Mon. to Sat..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, ANHTUAN NGUYEN can be reached on 571-272-4963. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



(Jackie) Tan-Uyen T. Ho  
Patent Examiner  
Art Unit 3731

January 5, 2005